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Supreme Court of the United States

October Term, 1942.

CELANESE CORPORATION OF AMERICA,
Petitioner,

—vs.—

LIBBEY-OWENS-FORD GLASS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States of America:

Your petitioner the Celanese Corporation of America respectfully prays for a writ of certiorari directed to the United States Circuit Court of Appeals for the Sixth Circuit to review the final judgment of that Court rendered in this action on April 22, 1943. The transcript of record is being filed herewith in accordance with Rule 41 of this Court.

Opinion Below.

The opinion and judgment of said Circuit Court of Appeals will be found at pages 1903 and 1904 of said record; the former is reported at 135 F. (2d) 138.*

* For convenience, in accordance with the opinion of the Circuit Court of Appeals, the Celanese Corporation will hereinafter be referred to as plaintiff and the Libbey-Owens-Ford Glass Company will be referred to as defendant.

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code (28 USC 347, as amended).

Questions Presented.

1. Whether patent 1,936,044 is for a novel improvement in laminated glass, or for a chemical compound.

2. Whether the said opinion of the Circuit Court of Appeals is in conflict with the decision of this Court in *Winans* v. *Denmead,* 15 Howard 330, and other decisions of this Court, following *Winans* v. *Denmead,** upon the question of infringement.

Summary Statement of the Matter Involved.

Plaintiff's predecessor in this action, the Celluloid Corporation, on October 23, 1934 filed in the United States District Court for the Northern District of Ohio its bill of complaint, charging the defendant with infringement of United States Letters Patent No. 1,936,044 issued on November 21, 1933 for *Laminated Product and Method of Producing Same.*

The claims in issue were 1 and 3 to 7 inclusive.

On June 29, 1939, the District Court appointed Amos L. Conn, Esquire, as Special Master to hear and determine the issues in the case (R. 54). The Special Master treating the patent as for a chemical composition on November 7, 1940 reported that claims 1, 3 and 4 were invalid and claims 1, 3, 4, 5, 6 and 7 were not infringed (R. 1847), and that claims 5, 6 and 7 were valid (R. 1836) but not infringed (R. 1842, 1843).

Upon the questions of confirmation of the Special Master's report before the Honorable Leslie R. Darr, District Judge, the Court on July 10, 1941, treating the

* *Smith* v. *Snow,* 294 U. S. 1, 14.

patent as a novel improvement in the art of laminated glass overruled the report of the Special Master, held the patent valid and infringed and directed the entry of the usual interlocutory decree holding validity and infringement and ordering an accounting for profits and damages.

Judge Darr's opinion and decree will be found at R. 1866 and 1882.

Upon appeal from Judge Darr's decree the Circuit Court of Appeals treated the patent as a patent for a chemical compound and held it anticipated. The Court also held that defendant having exceeded the proportions of plasticizer specified in the claims in suit did not infringe. Other grounds in support of its finding are referred to in the opinion and will be considered hereinafter.

Reasons Relied Upon for the Allowance of the Writ of Certiorari.

(1) Because the Circuit Court of Appeals for the Sixth Circuit has departed from the fundamental basis that the issue in the patent suit is the *invention as set forth in the patent,* and has decided the case as though the patent were for some new chemical composition, whereas Walsh made no claim for a new chemical composition.

(2) Because the Circuit Court of Appeals for the Sixth Circuit in finding that the claims in suit were not infringed relied upon the defendant's use of a small excess of plasticizer over that specified in the claims, whereby the defendant merely carried Walsh's teachings slightly further without change in function or mode of operation, the slight increase being merely verbal, but not functional. In so doing the Court rendered a decision in conflict with the decision of this Court in *Winans* v. *Denmead*, 15 Howard 330, and other subsequent decisions of this Court.

(3) Because the Circuit Court of Appeals for the Sixth Circuit in rendering its decision did not give effect to the fact that Walsh brought to the art a novel laminated

glass, including for the first time in such art a soft, rubberlike interlayer between the glass plates, whereby the interlayer accommodated itself to irregularities in the glass, yielded to blows upon the glass and spread the shock over greater area; that his invention was immediately adopted by the defendant and has proven to be a valuable step in the laminated glass art. The Walsh patent is not unduly broad but covers only a definite field and the defendant has made use of the Walsh invention within that field.

Dated July, 1943.

DRURY W. COOPER,
CLIFTON V. EDWARDS,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The Walsh Invention.

Prior to the Walsh invention the only laminated glass products on the market, or disclosed in prior patents or publications*, comprised two sheets of glass of a *hard* interlayer. This interlayer was made up of cellulose nitrate with 34-45 parts of camphor (R. 147; 425, 426; 442-444). Camphor is a plasticizer; it is a hard, but volatile substance, boiling at about 209° C. (R. 464, 575, 1295). When cooled the camphor is hard, thus making a hard interlayer to match the hard glass. It was customary to use a binder between the glass and the cellulose nitrate camphor composition. Gelatin, when cold, is hard and brittle.°

The District Court found as a fact (Finding of Fact No. 4, R. 1874) as follows:—

> "4. Prior to Walsh it had generally been the practice to interpose between two glass sheets or plates a hardened sheet of preferably cellulose nitrate with volatile plastifier such as camphor. This hard layer was caused to adhere to the sheets or plates of glass by a gelatin binder. An objection to such laminated glass was due to the hardness of the sheet or layer. The binder was not always able to cause it to adhere uniformly throughout, where irregularities existed. Other objections were that changes of temperature and stresses would cause the hard layers to separate from the glass sheets so that upon impact and breakage, the glass would splinter and fly."

Walsh in the patent in suit No. 1,936,044 of November 21, 1933 (R. 29), proposed to make the interlayer soft. His specification says (p. 1, lines 15-31):

---

* Except patent No. 1,831,462 to Moss, filed Oct. 20, 1928, as to which Walsh proved prior invention, found by the District Court (R. 1871, Finding of Fact, 18, R. 1879), but not disturbed by the Circuit Court of Appeals.

° Matieres Plastiques Artificielles, 1924, Defendant's Exhibit R, R. 1339.

> "Prior to my invention, laminated glass has been made by interposing thin sheets of a hard composition containing cellulose nitrate or pyroxylin between sheets of glass, and causing the same to unite by heat and pressure. These thin sheets of cellulosic material were quite rigid and tended to lose their volatile solvents, with the result that even when volatile solvents were applied to assist the union of the cellulosic sheets with the glass, great difficulty was experienced in causing firm adherence, even when great heat and pressure were applied. Moreover with the use of thin hard sheets of a composition containing derivative of cellulose, the laminated glass is of irregular thickness and has irregular stresses due to the tendency of the cellulosic sheet not to flow sufficiently."

The manner in which Walsh proposed to overcome these difficulties was to provide an interlayer of soft consistency resembling that of a rubberlike mass.* The specification states this as follows (page 1, lines 32-38):

> "I have found that the above described difficulties of poor welding and irregularities of the product may be obviated by employing as a laminating agent, a plastic composition containing derivatives of cellulose, which composition has a soft consistency resembling that of a rubber-like mass."

To accomplish this object, both in the manufacturing process and in the ultimate product, Walsh proposes (page 1, lines 39-44) to employ with the "derivative of cellulose" "sufficient non-volatile solvents or plasticizers to impart to the finished product such plasticity that it will readily flow under heat and pressure and a volatile solvent."

In order to specify how to attain the soft rubber-like mass the patent mentions a number of representative cellulose derivatives and a number of representative non-

* The term "rubber-like mass" had a well defined meaning in the art; see "resembling raw rubber" (Defendant's Ex. R, Vol. III, p. 1309), "rubbery" (Defendant's Ex. R, Vol. III, p. 1340), "properties of rubber" (Defendant's Ex. R, Vol. III, p. 1279), "like India rubber" (Defendant's Ex. R, Vol. III, pp. 1167, 1173).

volatile plastifiers (page 1, lines 48-61), and gives two examples of the proportion of plastifier to be used, one of which, using cellulose nitrate, is 50 to 75 parts per 100 parts cellulose nitrate (page 1, lines 85-87), and the other of which is 60 parts of plastifier with cellulose acetate (page 2, lines 18, 19). The claims in suit specify that the non-volatile plastifier shall be from the group "dibutyl phthalate, diethyl phthalate, dibutyl tartrate and triacetin" (claims 1 and 5), or "from the group consisting of phthalic acid esters" (claims 3 and 6), or a "non-volatile alkyl phthalate" (claims 4 and 7).

Walsh made no assertion or claim that the knowledge of the art was such that once instructed to make the cellulose derivative hard or soft it would be able to do so. The cellulose derivative art had been highly developed. It comprised derivatives of cellulose with various acids, ethers, etc., and the art was also familiar with plasticizers and that a small proportion of plasticizer tended to make a hard sheet and a larger quantity to make a soft sheet.

The specification states a number of cellulose derivatives and a number of plasticizers, all of which were well known, and the several plasticizers applicable to the several derivatives were also well known.

As stated in Finding of Fact No. 5 of the District Court, (R. 1874) Walsh's invention was to provide a soft yieldable interlayer in place of the old hard interlayer in the laminated prior art. The finding of fact referred to reads as follows:—

> "5. Walsh proposed to overcome these objections and defects in the prior art by providing an inner layer of soft, yieldable, plastic material, which would more nearly conform to the irregularities of the adjacent sheets or plates of glass, and would thus provide greater and more permanent and complete adhesion than in the case of a hard inner layer. This would prevent the glass from flying when struck by impact, and would absorb part of the impact and distribute it."

Walsh's Proposal was Novel and Contrary to the Prior Art.

In making this proposal, Walsh was going directly contrary to the prior art, which consistently held to the belief that the interlayer should be as hard as the glass; also that the proposal to increase the proportion of plasticizer meant weakening the interlayer.

It will be noted also that Walsh proposed to use only *non-volatile* plasticizers. In the old laminated glass camphor is volatile and hence after going through the manufacturing process of pressing the glass plates and the interlayer together under heat the result was necessarily a hard plasticizer. In Walsh the plasticizer, being non-volatile, is still present in sufficient quantity to keep the interlayer soft.

The Special Master and the Circuit Court of Appeals gave little heed to the fact that Walsh's patent was directed to and entitled an invention in laminated glass, and that the one step that he introduced in the laminated glass art was to use a soft rubber-like interlayer, and he gave examples thereof and specified proportions of the non-volatile solvent which would insure that softness.

The Walsh Claims in Suit.

The Walsh claims in suit read as follows:—

> 1. Laminated glass having sheets of glass united by a plastic composition containing a derivative of cellulose and 50-75%, based on the cellulose derivative, of non-volatile plastifier selected from the group consisting of dibutyl phthalate, diethyl phthalate, dibutyl tartrate and triacetin to render the same flowable under heat and pressure.
>
> 3. Laminated glass having sheets of glass united by a plastic composition containing a derivative of cellulose and 50 to 75%, based on the cellulose derivative, of a non-volatile plastifier selected from the group consisting of phthalic acid esters.

4. Laminated glass having sheets of glass united by a plastic composition containing cellulose acetate and 50 to 75%, based on the cellulose acetate, of a non-volatile alkyl phthalate.

5. The method of making a laminated glass, comprising interposing layers of a plastic composition containing a derivative of cellulose and 50-75%, based on the cellulose derivative, of non-volatile plastifiers selected from the group consisting of dibutyl phthalate, diethyl phthalate, dibutyl tartrate and triacetin to render the same flowable under heat and pressure between sheets of glass to be laminated, and then causing the plastic mass to coalesce under heat and pressure.

6. The method of making laminated glass, comprising interposing layers of a plastic composition containing a derivative of cellulose and 50 to 75%, based on the cellulose derivative, of non-volatile plastifiers selected from the group consisting of phthalic acid esters.

7. The method of making laminated glass, comprising interposing layers of a plastic composition containing cellulose acetate and 50 to 75%, based on the cellulose acetate, of a non-volatile alkyl phthalate.

In these claims the plastifiers specified, particularly the phthalates, were well known plastifiers, and by using large proportions thereof, "50-75%", Walsh insured the presence of a soft interlayer after the plates and interlayer had been heated and pressed in the manufacturing process.

Error of the Circuit Court of Appeals for the Sixth Circuit.

We submit that it was a fundamental error on the part of the Circuit Court of Appeals to enter into a critical comparison of different cellulose derivatives and plastifiers, all of which were well-known to the art, and to decide the case as though the patent were for the chemical compound or processes which Walsh did not claim, and ignore the one simple step which Walsh did claim.

Although Walsh's step was simple it was one of importance and its teaching was adopted by the defendant within the definite field of the patent. It is submitted that it is of the same order as the invention sustained by this Court in *Smith* v. *Snow*, 294 U. S. 1.

While the Circuit Court of Appeals held that there "was substantial and persuasive evidence to sustain findings of the Master that the three product claims in suit were invalid for want of novelty and want of disclosure" (R. 1918) and accepted the findings under Rule 53(e) (2) of the Federal Rules of Civil Procedure, yet this was done when construing the patent for a chemical compound or process instead of for laminated glass. Regardless of the findings made by the Master this Court has the power to correct this fundamental error for the contrary clearly appears upon the face of the patent itself as set forth previously herein.

While it is true that questions of validity and infringement of a patent are questions of fact for a jury, yet the nature and scope thereof are for the court.

In *Coupe* v. *Royer*, 155 U. S. 565 this Court said, in remanding the case in plaintiff's favor with instructions for a new trial, at page 580:

> "Our conclusion upon this part of the case, therefore, is, that the question of infringement, arising upon a comparison of the Royer patent and the machine used by the defendants, should be submitted to the jury, *with proper instructions as to the nature and scope of the plaintiff's patent* as hereinbefore defined, and as to the character of the defendants' machine". (emphasis supplied)

The Second Circuit Court of Appeals in *Brothers* v. *Lidgerwood Mfg. Co.*, 223 Fed. 359 in affirming a judgment based on a directed verdict for the defendant and in construing the patent valid but not infringed in view of the prior art, stated the rule succinctly at page 360:

> "It is well settled that when the validity of a patent is to be determined and its claim construed

by reference to prior patents, about the dates and authenticity of which there is no controversy, *the trial judge will usually construe those documents as he would other documents; his doing so does not invade the province of the jury.* There may be exceptional cases, but this is not one of them. The first questions, therefore, for this court to determine, are whether, in view of the prior art patents, the one in suit is valid, and what is the scope of its claims." (emphasis supplied)

Other cases supporting the same proposition are: *Heald* v. *Rice,* 104 U. S. 737; *Singer Manufacturing Company* v. *Cramer,* 192 U. S. 265; *Fond du Lac* v. *May,* 137 U. S. 395.

The Scope of the Walsh Claims.

Walsh's claims are all limited to proportions of 50 to 75 parts of plastifier. This range, roughly speaking, begins where the prior art left off, in proportions of plastifier. The file wrapper shows that the lower limit, 50, was put in to avoid the prior art, but the upper limit was not required by the prior art but put in voluntarily by the applicant in order to indicate a suitable range.

Plaintiff does not seek to avoid either the lower or the upper limit but does invoke the doctrine of *Winans* v. *Denmead,* 15 Howard 330, and subsequent cases, decided by this Court. In *Winans* v. *Denmead* this Court set forth the rule as follows (p. 343):

> "*It may safely be assumed that neither the patentee nor any other constructor has made or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle then, must a car be, in order to in-infringe? May it be slightly elliptical, or otherwise depart from a true circle, and if so how far?*
>
> In our judgment, the only answer that can be given to these questions is that it *must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain*

> *the same kind of result as was reached by his invention.*" (Italics by counsel.)

The Circuit Court of Appeals for the Sixth Circuit cited *Ives* v. *Hamilton*, 92 U. S. 426, in *United States Rubber Co.* v. *General Tire & Rubber Co.*, 128 Fed. (2d) 104, (C. C. A. 6th Circ.) and said (page 109):

> "Infringement is not avoided by change in degree, so long as the distinguishing function is retained, or by adding elements to the complete structure of the patent claim."

See also *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, where this Court said (page 415):

> "It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents, but that it was decided that the range of equivalents depends upon and varies with the degree of invention. See *Ives et al.* v. *Hamilton, Executor*, 92 U. S. 426; *Hoyt* v. *Horne*, 145 U. S. 302; *Deering* v. *Winona Harvester Works*, 155 U. S. 286; Walker on Patents, §362; Robinson on Patents, §258."

And in *Hoyt* v. *Horne*, 145 U. S. 302, this Court said (page 308):

> "It is insisted by the defendant in this connection that there is no infringement of the first claim of the Hoyt patent, since the pulp *is not circulated 'in vertical planes,' nor is it delivered by the beater-roll 'into the upper section of the vat,' as specified in that claim. Literally it is not.* A technical reading of the specification undoubtedly required that the mid-feather should run horizontally instead of vertically; but the object of this was that the pulp should be received and delivered by the beater-roll along its entire length, viz.: across the entire width of the tub, and this is accomplished in the same way in both devices. In both engines the beater-roll revolves toward the top of the dam or back-fall, and a similar acceleration of speed is obtained. How

> the pulp shall circulate at the other end of the tub is a matter of small consequence so long as it shall circulate in vertical planes at the point where it comes in contact with the roll." (Italics by counsel.)

As late as 1934 in *Smith* v. *Snow*, 294 U. S. 1, this Court said (p. 23):—

> "Petitioner does not avoid infringement of respondent's method patent merely by employing it in a machine of different structure than respondent's, whether more or less efficiently. *Winans* v. *Denmead*, 15 How. 330, 344; *Sewall* v. *Jones*, 91 U. S. 171, 184; *Cochrane* v. *Deener*, supra, 789; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 441."

Defendant used a non-volatile plastifier of the same class as the diethyl and dibutyl phthalates mentioned in the Walsh patent. In the upper limits of its compound defendant used from 68.4 parts to 84.45 parts of plasticizer in different types of product (R. 10-12). The plasticizer itself consisted in some cases of dimethyl phthalate and others dimethyl phthalate mixed with diethyl phthalate (one of those specifically mentioned in the patent). No question was raised but what the defendant's plasticizer was a non-volatile plasticizer and that the proportions given resulted in a soft yielding interlayer between the plates. No attempt was made by defendant to show that the slight excess of plasticizer gave any materially different result from that specified in the Walsh patent.

It is respectfully submitted that if patent claims are to be construed so literally as to free a defendant to make such mere colorable departures from the terminology of the claim as were made in this case, few patents would be of any value.

For a clear statement of the invention of the Walsh patent and the question of infringement, reference is respectfully had to the opinion of the Honorable Judge Darr in the District Court, beginning at R. 1866.

Conclusion.

Wherefore plaintiff respectfully prays that a petition for a writ of certiorari be granted, the case reviewed, and the judgment of the Circuit Court of Appeals for the Sixth Circuit be reversed.

Respectfully submitted,

DRURY W. COOPER,
CLIFTON V. EDWARDS,
Counsel for Petitioner.

(19)

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CHARLES ELMORE CROPLEY

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1943

CELANESE CORPORATION OF AMERICA,
Petitioner-Plaintiff,
vs.
LIBBEY-OWENS-FORD GLASS COMPANY,
Respondent-Defendant.

No. 149

DEFENDANT'S BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI.

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The second question, which goes to infringement, does not require decision because the patent is invalid. However, defendant does not infringe because (a) file wrapper estoppel and (b) the defendant does not employ the alleged invention of the patent in suit.... 2

As to the third reason advanced for allowance of the writ (which is in addition to "Questions Presented"), the Court of Appeals properly held the patent in suit invalid on five grounds. The Court found that the findings of the Master were supported by "substantial and persuasive evidence" and "overwhelming evidence" 3

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1943

CELANESE CORPORATION OF AMERICA, Petitioner-Plaintiff, vs. LIBBEY-OWENS-FORD GLASS COMPANY, Respondent-Defendant.	No. 149

DEFENDANT'S BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI.*

This is the usual patent infringement suit. It presents none of the grounds for certiorari stated in Rule 38 (5b) of the rules of this Court.

"QUESTIONS PRESENTED" by plaintiff are two (Pet., p. 2). Both of these are false issues. Further, whether real or false, they are not determinative.

The first question, as to whether the Walsh patent in suit is for laminated glass or chemical compound, is a false issue. The Court of Appeals did not misapprehend the subject-matter of the patent. The Court did not misapprehend the plaintiff's contentions. The same contentions urged in the petition were made before the Court of Appeals and the Master. Directly and specifically the Court of Appeals referred to safety or laminated glass twenty-eight times. The Court states:

*The petitioner will be referred to as "plaintiff" and the respondent will be referred to as "defendant."

"Plaintiff is most insistent that what was known about plastics is not to be confused with what was known about laminated glass" (R. 1909).

The second question stated by plaintiff (Pet., p. 2) goes only to infringement. The Walsh patent is plainly invalid on the several grounds stated by the Court of Appeals and on other grounds (see page 3 post). The question of infringement does not require decision. If it did, the patent is limited to 50-75% by weight of softener (plastifier or plasticizer) for 100% of cellulose base.* As to these limitations the Court of Appeals held that "plaintiff is confronted by file wrapper estoppel" inasmuch as Walsh inserted these limitations to get the claims allowed. (See C. C. A. opinion, R. 1915-16; also R. 1052, 1058, 1068.)** Defendant's articles and processes outside this range cannot infringe. Further, defendant could not infringe because it uses a softener, dimethyl phthalate, which is not set forth anywhere in the Walsh patent and is not the equivalent of any of the softeners which are set forth in the Walsh patent (see C. C. A. opinion, R. 1913; also R. 244).

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*Claim 1, a representative claim, reads (R. 830): "Laminated glass having sheets of glass united by a plastic composition containing a derivative of cellulose and 50-75%, based on the cellulose derivative, of non-volatile plastifier selected from the group consisting of dibutyl phthalate, diethyl phthalate, dibutyl tartrate and triacetin to render the same flowable under heat and pressure."

**To obtain allowance of the claims with these definite limitations, the same contentions urged in the petition as to the advantages of a "soft," "rubbery" interlayer were presented to the Patent Office and, as noted by the Court of Appeals, were relied upon by the Patent Office officials. However, the Master and Court of Appeals found these contentions to be contrary to fact (R. 1918).

The argument made respecting *Winans* v. *Denmead* (Pet., pp. 12-13) is not pertinent because the doctrine of equivalents may not be resorted to for the purpose of giving to claims a breadth which the patentee abandoned in order to get the patent issued (*Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U. S. 211; 1940). Plaintiff's "Question 2" is a moot question because of the invalidity of the claims.

As to "Reasons Relied Upon for the Allowance of the Writ of Certiorari" (Pet., p. 3), item 3 thereunder is in addition to "Questions Presented." The first part of item 3 relates to patentable invention and the second to scope. Scope has been sufficiently covered above.

In respect to patentable invention, the Court of Appeals held that the claims in suit of the Walsh patent are invalid because

1. anticipated by the prior art;

2. broader than the alleged invention; they cover many inoperable combinations;

3. the method claims specify an impractical process, lacking utility;

4. the patent lacks sufficient disclosure; it is based on a "hit or miss formula" (R. 1918);

5. the 50-75% limits in the claims are not critical and define no invention.

With respect to (1), anticipation, the Court of Appeals held that there was "substantial and persuasive evidence

to sustain the findings of the Master"* in this regard (R. 1918).**

Even if Walsh proposed a novel degree of "softness" of interlayer (which is contrary to fact), his change from the

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*The Master's Report is at R. 1807-48.

**The alleged novelty, as urged in the petition and before the Court of Appeals, is a "soft, rubber-like interlayer" (Pet., p. 4). Interlayers of the prior art laminated glass were softer than some of Walsh's interlayers. See R. 522-9; Plaintiff's Ex. 56, R. 859, which shows that a prior art interlayer of 40.2 parts of softener is softer than a Walsh interlayer of 50.2 parts of softener (cf. items 42 and 30 on Plaintiff's Ex. 56). See also R. 355-66; Defendant's Exhibits WWW and VVV, R. 1423, 1421. The Shuman prior art patent (R. 1149, lines 58-59) shows that the prior art well knew that the interlayer should be soft enough to mold to the glass. The Dreyfus patent (R. 1149-62) shows that the art knew that interlayers could be made softer by adding more softener. See also the Brier prior art patent (R. 1235). See R. 146-7, 464-5, where plaintiff's expert identified prior art commercial interlayers as "more rubbery" than the prior art interlayers and within the softness range of Walsh. With respect to this, the Court of Appeals said: " . . . such testimony indicated that the hardness of the plastic sheets was not the problem solved, or to be solved" (R. 1912). Also, "The problem of hardness was not pivotal; and the solution of the difficulties did not depend upon softness and flowability of the composition" (R. 1918).

The plaintiff erroneously says (Pet., p. 5) that the *entire* prior art (commercial, patent, and publication) employed only a cellulose nitrate-camphor interlayer. Those prior art patents discussed by the Court of Appeals are enough by way of illustration to refute this wholly erroneous statement by plaintiff. We, therefore, shall not list the many prior art patents in the record disclosing interlayers other than cellulose nitrate-camphor.

prior art would be only one of degree of softness for the same purpose. This would not involve invention.*

The plaintiff's effort to make capital out of Walsh's so-called "non-volatile" softeners (Pet., p. 8) is groundless.**

Regarding (2), the inoperable combinations claimed, the Court of Appeals found that "there was a mass of substantial and persuasive evidence that many of the named plastifiers do not work with, or plastify the various cellulose derivatives designated to be used by Walsh" (R. 1910).*** This was termed by the Court as "overwhelming evidence" (R. 1919).

With respect to (3), lack of utility of the method claims, the Court of Appeals found "the method itself is impractical . . . according to plaintiff's expert witness . . . " (R. 1919).****

With respect to (4), lack of sufficient disclosure, the Court of Appeals held:

> "The evidence in this case discloses that the Walsh patent was based on a hit or miss formula, which was

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*_Brady Brass Co._ v. _Ajax Metal Co.,_ 160 Fed. 84, 85 (C. C. A. 3; 1908; certiorari denied 210 U. S. 433).

**The Circuit Court of Appeals said that prior to Walsh, "It was known which plastifiers were more volatile than others, and it was also known that certain plastifiers would work more satisfactorily with some cellulose derivatives than with others" (R. 1909). See R. 341-2, 428-30.

***See R. 466, 104, 105-6, 297-301, 309. The Court of Appeals found that some of Walsh's claimed interlayers were "hard, opaque, brittle, flaky, and unstable; some of them turned to powder when they were cut or sliced; others were thick, 'cheesey' " (R. 1910).

****R. 86.

> not such a disclosure to those skilled in the plastic composition art or laminated glass art, as would enable them to practice its manufacture without experiment" (R. 1918).*

Regarding (5), the non-critical 50-75% limits in the claims, the Court of Appeals held:

> "While it is claimed that the proportions stated were critical, it appears otherwise from the evidence" (R. 1916).**

The defendant took nothing from the plaintiff. Plaintiff had nothing to give.

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*See R. 466, 104, 105-6, 297-301, 309, 355-66.

The Court of Appeals also said (R. 1915): "But, were we to assume (contrary to the Master's findings) that the use of such soft plastics in laminated glass was a novel contribution to the art, we are met by the fact that the patentee has claimed a great chemical kingdom; that within the ever contracting and expanding boundaries set by him, are multiform compounds that have none of the attributes necessary for the purposes of the claimed invention; that even among many of the compositions submitted as suitable for such purposes, numerous of them failed, being discolored, with bubbles and unlaminated spots; that the most successful of the compounds are found only by continuous experimentation; but that, nevertheless, it is sought to impress a title and ownership upon anything discovered by others within the unexplored regions of this vague domain."

**The plaintiff's expert witness testified that changes upon use of plastifier above 75% are gradual, and that "there are no sharp lines where you can say, 'this sheet works and that sheet does not.' It is a matter of relative degree" (R. 120). With respect to the lower limit of 50% the plaintiff's expert stated that changes below 50% are a matter of degree only; that 48 might do as well as 50 (R. 116).

As to the softeners set forth in the patent specification, the Master found as a fact that the record "does not disclose that a plastic interlayer for laminated glass using any one of the four plasticizers mentioned by Walsh as the sole plasticizer has ever been successfully used commercially by anyone" (Fact Finding 18, R. 1846).

The defendant has long been a large manufacturer of laminated glass. For years, as did other large manufacturers, it successfully made the product using cellulose nitrate interlayers. Defendant bought large quantities of cellulose nitrate interlayers from plaintiff which, in competition with other large concerns, was a manufacturer of plastics (R. 630, 411).

Defendant was anxious to improve the quality of its product. This could be done by using a cellulose acetate interlayer which was inherently weaker than cellulose nitrate but more retentive of clarity under thermal changes and sunlight action (R. 347-8).

Plaintiff endeavored to supply defendant with a satisfactory cellulose acetate interlayer. It failed. Though the Walsh patent application was filed in 1928, as late as 1930 (as the Court of Appeals points out in its opinion), defendant and other companies were corresponding, negotiating, and conferring with the plaintiff in an attempt to secure satisfactory cellulose acetate sheets for interlayers (R. 1914). In 1932 plaintiff advised that "cellulose acetate has not been perfected for laminated glass" (R. 1914; 1495). The Walsh patent application gave no help. As late as 1933 plaintiff was still unsuccessfully working on the problem.

Meanwhile one of plaintiff's competitors in the plastic field succeeded in producing satisfactory cellulose acetate interlayers for laminated glass. Defendant bought this

from plaintiff's competitor. It developed an adhesive for it (R. 343). An adhesive is necessary. The Walsh patent disclosed none that works with a cellulose acetate interlayer. In May, 1932, without any disclosure to it by plaintiff of the pending Walsh patent application, defendant began using these interlayers in its product (R. 410). It is only the defendant's cellulose acetate products and processes that are charged to infringe.

Eight months after plaintiff learned of this, which was five years after the Walsh patent application was filed, plaintiff sought to reap where it had not sown. It added Claims 3, 4, 6, and 7 to the Walsh application (R. 1085-88; 637). The four specific softeners mentioned in the patent specification gave no foundation for its endeavor in Claims 3, 4, 6, and 7 to broadly claim hundreds of softeners. This lack of emergence of these claims from the specification is another reason why the Walsh patent is invalid. The unconscionable nature of plaintiff's belated endeavor to take toll through grinding no grist is not to be tolerated. In mentioning some of these matters, the Court of Appeals in its opinion concludes with this observation:

> " . . . It is difficult to draw any inferences from the foregoing, except that those skilled in the art were unable to find from Walsh's specifications and claims, the suitable plastifiers, the particular derivatives, and the proper proportions of each for the desired composition, without multitudinous experiments" (R. 1914).

This presents still another reason why the Walsh patent is void.

The Walsh patent is plainly invalid. The Master's findings of fact were well grounded. The Circuit Court of

Appeals' opinion discloses a thorough understanding of the cause. Its determinations are abundantly supported on the record.

Respectfully submitted,

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